

**REMARKS****Summary of the Office Action**

Claims 1 and 3 stand rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Sandhu et al.(US 5,658,183).

Claims 2 and 7 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Ushio et al. (US 6,271,047).

Claims 4-6 and 8-12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ushio ('047) and further in view of Sandhu.

Claims 1, 2, and 7 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of Ushio et al. ('047).

**Summary of the Response to the Office Action**

Applicants have amended claim 1 to further define the invention, and amended claim 2. Claims 13-24 are withdrawn from consideration. Accordingly, claims 1-24 are pending for consideration.

Applicants submit concurrently herewith a Supplemental Declaration claiming priority to Ushio et al. (US 6,271,047), and a Claim for Priority. Accordingly, Applicants have amended the specification to make reference to Ushio et al. ('047). Applicants also authorize the fee of \$1,300.00, as set forth in 37 CFR 1.17(c), to be charged to Deposit Account No. 50-0310.

**All Claims Define Allowable Subject Matter**

Claims 1 and 3 stand rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Sandhu et al.(US 5,658,183). Applicants respectfully traverse the rejection for at least the following reasons.

Independent claim 1, as amended, recites a detection apparatus including “irradiating a substrate face with light of multiple wavelength components.” In contrast to Applicant’s claimed invention, Sandhu et al. teaches (col. 8, lines 1-10, and FIG. 1) using a film thickness measurement device 60 using a laser interferometer including a laser source and controller 64. Accordingly, Applicants respectfully assert that the apparatus taught by Sandhu et al. includes irradiation using a single wavelength. Thus, Sandhu et al. fails to teach or suggest “irradiating a substrate face with light of multiple wavelength components,” as recited by amended independent claim 1, and hence dependent claim 3.

Claims 2 and 7 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Ushio et al. (US 6,271,047), and claims 4-6 and 8-12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ushio (‘047) and further in view of Sandhu. Applicants respectfully traverse these rejections for at least the following reasons.

Applicants respectfully submit that Ushio et al. (‘047) is not prior art to the present invention. Specifically, since the present invention now claims priority to Ushio et al. (‘047) under 35 U.S.C. § 120, Applicants respectfully assert that Ushio et al. (‘047) cannot be used as prior art against the present invention. That is, Applicants respectfully assert that any claims potentially anticipated by Ushio et al. (‘047) are supported by Ushio et al. (‘047) to which the present application claims benefit. Moreover, the present application was filed on March 29, 2001, and therefore is governed by 35 U.S.C. § 103(c) as revised on November 29, 1999. The subject matter of Ushio et al. (‘047) and the present invention were, at the time the invention was made, commonly owned by Nikon Corporation of Tokyo, Japan. Therefore, the disclosure of Ushio et al. (‘047) cannot preclude the patentability of the present invention under 35 U.S.C.

§ 103(c). In addition, as detailed above, since the present invention claims priority to Ushio et al. ('047) under 35 U.S.C. § 120, Applicants respectfully assert that Ushio et al. ('047) cannot be used as prior art against the present invention. Thus, Applicants respectfully assert that the rejections under 35 U.S.C. §§ 102(e) and 103(a) based on Ushio et al. ('047) should be withdrawn.

Claims 1, 2, and 7 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of Ushio et al. ('047). Applicants respectfully traverse the rejection for at least the following reasons.

Independent claims 1, 2, and 7, as amended, all recite a detection apparatus. In contrast to Applicants' claimed invention, claims 1-5 of Ushio et al. ('047) recite a method for determining a thickness of a surficial thin-film layer on a substrate. Although the Office Action alleges that an apparatus is inherent from the method of claims 1-5 of Ushio et al. ('047), Applicants respectfully submit that Ushio et al. ('047) was subject to a Restriction Requirement. As instructed by MPEP 804(B)(1), "[o]bviousness-type double patenting requires rejection of an application claim when the claimed subject matter is **not patentably distinct** from the subject matter claimed in a commonly owned patent when the issuance of a second patent would provide unjustified extension of the term of the right to exclude granted by a patent. *See Eli Lilly & Co. v. Barr Labs., Inc.*, 251 F.3d 955, 58 USPQ2d 1865 (Fed. Cir. 2001); *Ex parte Davis*, 56 USPQ2d 1434, 1435-36 (Bd. Pat. App. & Inter. 2000)." Accordingly, Applicants respectfully submit that since the Office has previously established that the method claims 1-5 of Ushio et al. ('047) *are patentably distinct* from apparatus claims 1-9 of Ushio et al. (US 6,670,200), no apparatus inherently exists from the method claims 1-5 of Ushio et al. ('047).

Therefore, Applicants respectfully requests that the rejection of claims 1, 2, and 7 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of Ushio et al. ('047) be withdrawn.


### **CONCLUSION**

In view of the foregoing, Applicants respectfully request reconsideration and timely allowance of the pending claims. Should the Examiner believe that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicants' undersigned representative to expedite prosecution.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

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